

REMARKS

In this Amendment, Applicants cancel claim 19, without prejudice or disclaimer of its subject matter, and amend claims 1, 10, 12, 17, 25, 26, 31, 40 and 42 to more appropriately define the present invention. Upon entry of this Amendment, claims 1-18 and 20-46 remain pending and under current examination.

I. Office Action Summary:

In the Office Action dated January 30, 2004, the Examiner rejected claims 1-7, 9-13, 17-26, 31-37, and 39-43 under 35 U.S.C. § 103(a) as being unpatentable over *Kennedy, III et al.* (U.S. Patent No. 6,405,033) in view of *Riskin* (U.S. Patent No. 4,757,267); and rejected claims 8, 14-16, 27-30, 38, and 44-46 as being unpatentable over *Kennedy III et al.* in view of *Riskin* and further in view of *Falcon et al.* (U.S. Patent Publication Number 2002/0076031).

II. Amendments to claims 1, 10, 12, 17, 25, 26, 31, 40 and 42:

Applicants have amended claims 1, 17, 25, 26, 31, 40, and 42 to more appropriately define the invention. In particular, Applicants have amended claim 1 to require a step of requesting a calling party to select one of a plurality of related *types of a first service* when a trigger number matches a predetermined trigger number. Support for Applicants' amendment to claim 1 may be found in the specification, for example, at page 7, describing a Service Logic Program that determines whether a trigger number of a received call is associated with a trigger number only advertised by ISPs. If there is a match, the call is "processed by forwarding SLP operations to query the calling party for *types of ADSL service* desired (Step 220)" (see specification at page 7, lines 25-27).

Similar changes have been made to claims 17 and 31, and are thus also deemed supported by Applicants' disclosure.

Applicants have also amended claims 10, 12, 25, 26, 40 and 42 to change detecting an "error," as required by each of these claims to detecting a "network failure." Support for Applicants' changes to claims 10, 12, 25, 26, 40 and 42 may be found, for example, in the specification at page 12, line 26- page 13, line 3.

III. Claims 1-18 and 20-43 Are Not Obvious Over The Examiner's Proposed Combinations Of Kennedy et al., Riskin, and Falcon et al.:

Applicant respectfully traverses the rejection of claims 1-7, 9-13, 17-26, 31-37, and 39-43 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established by the Examiner.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Applicants respectfully submit that the Examiner has not established that all the elements of Applicants' claims are met in the cited references, has not shown that there is any suggestion or motivation to modify the cited references to result in the claimed invention, and has failed to establish any reasonable expectation of success from doing so.

A. The Prior Art references relied on do not teach or suggest all of the claim elements

Amended claim 1 is not obvious over *Kennedy et al.* and *Riskin* because neither reference taken alone or in combination teaches or suggests each and every element of these claims. In particular, the applied references fail to teach or suggest the step "requesting the calling party to **select one of a plurality of related types of the first service** in response to the determination that the trigger number matches the predetermined trigger number," as recited in amended claim 1.

The Examiner acknowledges on page 3 of the Office Action that "[w]hat *Kennedy et al.* does not teach is matching a trigger number to a predetermined trigger number and requesting selection of various services depending on whether or not the trigger number match up," but relies on *Riskin*, allegedly for disclosing such subject matter. Specifically, the Examiner contends on page 4 of the Office Action, that "Riskin teaches a system wherein a caller may call into a director/service center/routing center using for example an 800 number that is associated with a certain service/dealer and if the dialed number, i.e., the trigger number matches of those 800 numbers, a caller will be connected to a service center/dealer handling the associated service" citing column 15, lines 55 – column 16, line 44 of *Riskin*.

Riskin, however, requires a caller to enter extensions to select from "many *different* advertisers, products, and advertisements" when a dialed number is a CDSC number such as 1-800-USA-DIAL (Emphasis added. See col. 15, line 67-col. 16, line 3). *Riskin* also teaches that if a number other than 1-800-USA-DIAL is dialed, "an extension is required to differentiate between several products and advertisements of a given

advertiser" (col. 16, lines 38-41). Accordingly, *Riskin* is limited to selection of *different* products when a called number matches a the 1-800-USA-DIAL or some other 800 number. Amended claim 1, in contrast, requests a caller to select one of a plurality of *related* types of a first service when a trigger number matches a predetermined trigger number. Accordingly, claim 1 is distinguishable over *Riskin*. Moreover, since the Examiner concedes that *Kennedy et al.* does not even teach matching trigger number with a predetermined trigger number, Applicants respectfully submit that neither reference teaches the claimed step of requesting the calling party to select one of a plurality of related types of the first service in response to the determination the that trigger number matches the predetermined trigger number, as recited in amended claim 1.

Amended claim 17 recites a switching control node that forwards requests to the calling party to select "one of a plurality of related types of a first service", and amended claim 31 recites a step of "requesting the calling party to select one of a plurality of related types" of a first service. Amended claims 17 and 31 are therefore similar to amended claim 1 in this respect, and are therefore distinguishable over *Kennedy et al.* and *Riskin* at least for reasons discussed above in regard to amended claim 1.

Amended claim 10 indirectly depends from claim 1, and further requires steps of detecting a network fault and rerouting a call to a first auxiliary center. The Examiner fails to cite any teaching in *Kennedy et al.* of such detecting and rerouting, but argues that *Riskin* teaches routing of calls in the event a dealer is busy or not answering. Applicants respectfully submit, however, that a busy line or an unanswered call are not the result of an equipment failure. Accordingly, such disclosure cannot constitute a

teaching of network faults recited in claim 10, which are equated with such equipment failures (see for example, the specification at page 13, lines 9-10). Claim 10 is therefore distinguishable over *Kennedy et al.* and *Riskin* for this reason in addition to the reasons discussed above in regard to claim 1. Moreover, claims 12, 25, 28, 40 and 42, which similarly require detection of network faults, are also distinguishable over the Examiner's proposed combination of references.

In light of the above described deficiencies of both *Kennedy et al.* and *Riskin*, Applicants respectfully submit that claims 1, 17 and 31 are allowable over the applied references. Further claims 2-7, 9-13 are allowable at least due to their dependence from claim 1; claims 18, and 20-22 are allowable at least due to their dependence from claim 17; and claims 32 and 33 are allowable at least due to their dependence from claim 31.

Applicants respectfully traverse the Examiner rejection of claims 8, 14-16, 38, and 44-46 as being unpatentable over *Kennedy et al.*, *Riskin* and *Falcon et al.* Each of claims 8, 14-16, 38 and 44-46 depend from one of independent claims 1, 17, and 31, and are thus allowable over the Examiner's proposed combination of *Kennedy et al.* and *Riskin* for reasons discussed above. At page 4 of the Office Action, the Examiner relies on *Falcon et al.* allegedly for teaching status information including abandoned calls. Such teachings, even if present in *Falcon et al.*, fail to overcome the above-described shortcomings of both *Kennedy et al.* and *Riskin*. Accordingly, claims 8, 14-16 are allowable at least due their dependence from claim 1; claims 27-30 are allowable at least due to their dependence from claim 17; and claims 38 and 44-46 are allowable at least due to their dependence from claim 31.

Moreover, Applicants note additional features recited in claims 27 and 28 which are neither taught nor suggested by the applied prior art. In particular, both claims 27 and 28 recite a test call generator that generates test calls to verify whether a switching control node receives the test call (claim 27) and verify that the switching control node activates a service logic program in response to the switching node receiving the test calls, among other limitations (claim 28). Without citing any teachings in either *Riskin* or *Falcon et al.*, the Examiner only relies on portions of columns 9, 10 and 19 of *Kennedy et al.* in asserting that the claimed test call generator is disclosed in *Kennedy et al.* Applicants respectfully disagree (see Office Action at page 8).

At column 9, line 66-column 10, line 2, *Kennedy et al.* describes diagnostic tests of components contained in a mobile unit ("[U]ser interface 22 and platform 24 enable an operator of mobile unit 12 to perform diagnostic tests on sensors 26, actuators 28, computing devices 30"). Such diagnostic testing of a mobile unit itself does not involve placing a call, and is therefore unrelated to the claimed test generator that generates test calls for verifying receipt by a switching node. Moreover, the "audio mode" described at column 19 of *Kennedy et al.* is implemented to "verify proper communication between mobile unit 12 and NSC 14 (see col. 19, lines 27-32). The "audio mode," however, apparently can only be implemented once communication between mobile unit 12 and NSC 14 has been established, but cannot be used to verify whether such communication can be made at the outset. In addition, neither the mobile unit nor NSC 14 constitute a test generator or switching node, as recited in claims 27 and 28. The teachings at column 19, therefore, also fail to suggest the claimed test call

generator and switching node, as recited in these claims. Claims 27 and 28 are thus further allowable at least due to their dependence from claim 17.

B. Lack of motivation or suggestion to modify or combine references

The M.P.E.P. sets forth:

"Obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." "[I]t is necessary to ascertain whether or not the reference teaching would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification."

M.P.E.P. § 2143.01, emphasis added.

One skilled in the art would only arrive at the present claimed invention by consulting Applicants' disclosure, yet "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." M.P.E.P. § 2142, internal citations omitted. However, the Examiner is relying on Applicants' present invention in an attempt to provide some teaching or suggestion to combine *Kennedy et al.*, and *Riskin* or *Kennedy, Riskin* and *Falcon et al.* Such reliance, however, would constitute improper hindsight reasoning. Applicants submit that the proposed combinations of *Kennedy et al.* and *Riskin* and *Kennedy, Riskin* and *Falcon et al.* do not provide the requisite motivation to one of ordinary skill in the art to facilitate their combination, from within the references themselves. Applicants also note that one of ordinary skill in the art must

have this motivation or reason *without the benefit of Applicants' specification* to modify the references.

The proposed combinations of *Kennedy et al.* and *Riskin* and *Kennedy, Riskin* and *Falcon et al.* fail to provide the requisite motivation to facilitate their combination for the following reasons. *Kennedy et al.* routes calls from a mobile unit to a service center where the mobile unit communicates a service message in a call using the voice network. (Col. 1: 54-58) **The network switching center receives the service message communicated by the mobile unit, selects one service center in response to the service message, and establishes a communication session between them.** (Col. 1: 59-63) The service message identifies the mobile unit, the class of services requested, the location of the mobile unit, and other information that can be used by the Network Switching Centers to route the call from the mobile unit to the appropriate service center, as well as by the service center to provide the requested service. (Col. 2:6-21)

Riskin on the other hand, either **automatically** connects a customer with a dealer of goods or services, or **allows the customer to further choose an extension.** If the dialed number is a CDSC number, then the caller has to further choose an extension before being connected to the dealer. (Col. 15: 67-Col. 16: 6). If the dialed number is one that is provided by the advertiser, there is no need to solicit an extension and the connection between the caller and the dealer can proceed "with no interaction at all between the computer and the caller" (Col. 16: 35-37). There are also circumstances where an extension is required even if the number is not the CDSC number. (Col. 16:38-40). Therefore, while in the *Kennedy et al.* system, the networking switch center chooses a service based on the service message, in *Riskin*, either the

number identifies a particular advertiser or dealer, or the caller has to specify an extension. As a result, one of ordinary skill in the art would not combine the two references. Further, *Falcon et al.* at most provides isolated teachings of status information of abandoned calls.

Applicants respectfully remind the Examiner that "[t]he initial burden is on the Examiner to provide some suggestion of the desirability of doing what the Inventor has done." M.P.E.P. § 2142. The prior art references themselves must provide the motivation to combine, and the presently applied references clearly fail to do so, therefore failing to provide some suggestion of the desirability of doing what Applicants have done.

As previously demonstrated, such combination of these references *a priori* fails to establish obviousness of the claimed invention. Furthermore, Applicants have pointed out deficiencies in the cited prior art that render insignificant any indication that the cited references would give any motivation or reason to one of ordinary skill in the art to modify them *without the benefits of Applicants' specification*.

Further, the Examiner alleges on page 4, that "[I]t would have been obvious for one of ordinary skill in the art at the time the invention was made to have combined the teachings of *Kennedy et al.* and *Riskin* inasmuch as both systems are drawn to servicing a call request via a plurality of service centers/call centers. Moreover, *Riskin's* teaching of a trigger number being 'keyed'/associated with a specific service/service center is very old and well known." Applicant disagrees with the Examiner's allegations and conclusions as an unsubstantiated statement of questionable relevance to Applicant's claimed invention. Applicant further refers the Examiner to the February 21,

2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice." In relevant part, the Memorandum states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding" (Memorandum, p. 3). Further, the Memorandum indicates that the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." *Id.* at 1.

Applicant submits that "[d]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense." In *re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Should the Examiner maintain the rejection after considering the arguments presented herein, Applicants submit that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to official notice and [allow Applicants] to challenge the assertion in the next reply after the Office Action in which the common knowledge statement was made" (*Id.* at 3, emphasis in original), or else withdraw the rejection.

C. Lack of reasonable expectation of success

In addition, regarding the required reasonable expectation of success, as evidenced from previous arguments regarding *Kennedy et al.*, *Riskin*, and *Falcon et al.* Applicants submit that there would be no reasonable expectation of success to be

derived from modifying *Kennedy et al.* with *Riskin* , as this would diverge from the present invention, as claimed in Applicants' independent claims 1, 17, and 31. This also demonstrates that the Examiner's reliance on *Kennedy et al.* and *Riskin* is not sufficient to establish *prima facie* obviousness.

Thus, Applicants submit that the Examiner's reliance on these references fails to establish *prima facie* obviousness. Therefore, Applicants submit that independent claims 1, 17, and 31 are allowable, for the reasons argued above. In addition, dependent claims 2-18 and 20-43 are also allowable at least by virtue of their respective dependence from one of allowable base claims 1, 17, and 31. Therefore, Applicants respectfully submit that the Examiner should withdraw the 35 U.S.C. § 103(a) rejections.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2347.

Respectfully submitted,

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